

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Priority Claim

Applicant respectfully requests that the Examiner acknowledge the claim of foreign priority. The present application claims priority to European Patent Application EPO 04290782.4 filed on March 23, 2004.

Disposition of Claims

Claims 1-21 are pending in this application. Claim 1 is independent. The remaining claims depend, directly or indirectly, from independent claim 1.

Rejections under 35 U.S.C. § 102

Claims 1-21 stand rejected¹ under 35 U.S.C. § 102 as unpatentable over WO 2004/019261 (“Nishikawa”). *See* OA: page 2 #4. To the extent this rejection applies to the pending claims, the rejection is respectfully traversed.

¹ Applicant notes that, in the OA, the Examiner’s rejection actually specifies a rejection of claims 1-22. However, because only claims 1-21 are pending in this application, Applicant will treat the Examiner’s rejection as a rejection of all the pending claims.

I. Pending Independent Claim 1

Pending independent claim 1 recites a portable communication device for at least mono-directional communication with a terminal, comprising: (i) a micro-module, comprising: a chip, comprising an antenna allowing the micro-module to communicate with the terminal when the antenna is placed in a vicinity of the terminal; and (ii) a reader configured to receive the micro-module, wherein said antenna is held by said reader such that the micro-module is removable relative to the antenna.

II. The Cited Prior Art Reference Relied Upon by the Rejection

In rejecting the pending claims, the Examiner relies upon Nishikawa to disclose all the elements of the pending claims. *See* OA: pages 2-4. Nishikawa discloses a first example where a receiving device for a SIM card is a mobile phone. *See, e.g.*, Nishikawa: page 3 lines 1-10; and page 16 lines 2-7. In addition, Nishikawa discloses a second example where a receiving device for a SIM card is a key-holding device. *See, e.g.*, Nishikawa: page 20 lines 21-29; page 12 lines 8-10; and FIGs. 8 and 9. Because Nishikawa is silent as to the possibility that the device of the first example (*i.e.*, mobile telephone) and the device of the second example (*i.e.*, key-holder) are combinable, Applicant respectfully asserts that the first example and the second example are exclusive of each other and therefore serve as separate self-contained examples within Nishikawa.

III. Summarizing the Examiner's Rejection of Pending Independent Claim 1

Turning to the rejection of pending independent claim 1, the Examiner relies upon Nishikawa's FIG. 8 (*i.e.*, Nishikawa's second example: key-holder) to disclose "a portable communication device" as recited by pending independent claim 1. *See* OA: page 2 #4. Further, the Examiner relies upon Nishikawa's discussion of a portable/mobile telephone (*i.e.*, Nishikawa's first

example) to disclose “at least mono-directional communication with a terminal” as recited by pending independent claim 1. *See* OA: page 2 #4. As such, in rejecting pending independent claim 1, the Examiner is clearly relying upon Nishikawa’s first example as well as Nishikawa’s second example.

IV. The Legal Standard for a Proper Rejection under 35 U.S.C. § 102

Under 35 U.S.C. § 102, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Further, “[t]he identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

In *Net MoneyIN, Inc. v. VeriSign, Inc.*, the Court of Appeals for the Federal Circuit has further clarified the legal standard for making a proper rejection under 35 U.S.C. § 102. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1368 (Fed. Cir. 2008). The claim at issue in *Net MoneyIN* involved an Internet payment system comprising five “links” (*i.e.*, claim elements). *Net MoneyIN* at 1368-1369. The claim was held to be anticipated and therefore invalid by a district court, which found all five of the recited links in a single prior art reference, albeit in two separate disclosed examples. *Net MoneyIN* at 1369. Specifically, the relied-upon prior art reference discloses two separate protocols for processing an Internet credit card transaction. *Net MoneyIN* at 1371. However, neither of the disclosed protocols contains all five links arranged or combined in the same way as the claim at issue. *Id.*

In reversing the district court, the Federal Circuit clarified that:

“[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed, and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added).

Under this rationale, the Federal Circuit held that the district court was wrong to combine parts of two separate examples shown in the cited prior art reference to make its finding that the claim was anticipated. *Net MoneyIN* at 1371. Because the Federal Circuit continues to uphold the aforementioned rule of *Net MoneyIN* (see, e.g., *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325 (Fed. Cir. 2010)), Applicant respectfully asserts that the Examiner’s rejection of pending claims under 35 U.S.C. § 102 must comply with the requirements of the legal standard as described above.

V. The Examiner’s Rejection is Improper

Applicant respectfully asserts that the Examiner’s rejection of pending independent claim 1 under 35 U.S.C. § 102 is improper under the holding of the Court of Appeals for the Federal Circuit in *Net MoneyIN, Inc. v. Verisign, Inc.* 545 F.3d 1359, 1367 (Fed. Cir. 2008). As discussed, under *Net MoneyIN*, a proper rejection for anticipation under 35 U.S.C. § 102 requires a showing that the cited prior art reference discloses all of the claimed limitations *arranged or combined in the same way* as recited in the rejected claim. Moreover, the Federal Circuit held that the district court was wrong to combine parts of two separate examples shown in the cited prior art reference to make its finding that the claim was anticipated.

Similar to the district court in *Net MoneyIN*, the Examiner relied upon features found in two separate examples (e.g., Nishikawa's first and second examples as discussed above) in a prior art reference. Specifically, Applicant respectfully asserts that Nishikawa's first example citing a portable/mobile telephone is clearly exclusive from Nishikawa's second example citing a key-holder device. Because the Examiner's rejection of pending independent claim 1 clearly relies on both the first example and the second example, the Examiner has effectively combined parts of two separate examples shown in Nishikawa to make a finding that the pending independent claim 1 was anticipated by Nishikawa. As such, the Examiner's rejection of pending independent claim 1 under 35 U.S.C. § 102 is contrary to the holding of *Net MoneyIN* and therefore improper. Moreover, the Examiner's rejection of depending claims are improper for at least the same reasons as discussed with respect to pending independent claim 1. Accordingly, withdrawal of the rejection under 35 U.S.C. § 102 is respectfully requested with respect to the pending claims.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/094001).

Dated: April 22, 2010

Respectfully submitted,

By /Jonathan P. Osha/
Jonathan P. Osha
Registration No.: 33,986
OSHA · LIANG LLP
909 Fannin St., Suite 3500
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant